

TAKAHASHI et al. -- 10/602,690  
Attorney Docket: 008378/0303622

- §1.116 AMENDMENT -

### REMARKS

Reconsideration and timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the pending Office Action, the Examiner rejected claims 1, 3-7, and 9-11, under 35 U.S.C. §102(b), as allegedly being anticipated by D'Assignies '913 (U.S. Patent No. 3,608,913).

By this Amendment, Applicants have cancelled claim 3, without prejudice or disclaimer, and have amended independent claims 1 and 6 to provide a clearer presentation of the claimed invention. Applicants submit that no new matter has been introduced. Accordingly, claims 1, 4-7, and 9-11 are once again presented for examination of which claims 1 and 6 remain as the sole independent claims.

Applicants traverse the prior art rejections of the claims, under 35 U.S.C. §102(b), for the reasons presented below.

#### I. Prior Art Rejections Under §102(b).

Independent claim 1, as amended, positively recites the use of a *vacant gap portion* disposed directly opposite to said protrusion *that is configured to collapse* when compressed in the axial direction of said seal. Claim 1 also positively recites that *an embedding portion is embedded in an entire portion of a space between said legs of said letter X*, on a bushing-side of said intersection of said legs of said letter X and on an intersection-side of said plane connecting bushing-side end portions of the legs of said letter X, with a seal material. Such features are amply supported by the described embodiments in the Specification. (*See, e.g.,* Specification: FIGs. 2-4).

Unlike the present invention, there is nothing in the D'Assignies '913 reference that teaches the combination of elements recited by amended claim 1. Most notably, D'Assignies '913 discloses the use of an elastomeric ring 1 that is inserted within a groove 4 that is positioned opposite to flat top central annular rib (protrusion) 5. (*See, e.g., D'Assignies '913*: col. 2, lines 1-4; FIGs. 1, 3-5). It will be appreciated that the

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inserted elastomeric ring 1 prevents the annular groove 4 from collapsing when the packing gland is compressed. Such a configuration is in direct contrast to the claimed invention which requires that the gap portion be vacant and that it collapses when compressed in the axial direction of said seal. Thus, not only does D'Assignies '913 fail to teach or suggest these claimed features, it appears that the reference clearly teaches away from them.

It will also be appreciated that, by virtue of the D'Assignies '913 packing gland configuration, the flat top central annular rib (protrusion) 5 will only embed a portion of the space between the outer and inner ribs (legs of the letter X) 6, 7. (See, e.g., D'Assignies '913: FIGs. 1, 3-5). As such, D'Assignies '913 also fails to teach or suggest that the embedding portion is embedded in an entire portion of a space between said legs of said letter X, as required by claim 1.

Finally, Applicants respectfully remind the Examiner that in the first Office Action of August 26, 2004, the Examiner clearly indicated that the invention, as then claimed, was patentable over D'Assignies '913. It thus appears incongruous and illogical to later assert this reference, as being anticipatory, when the invention has been further limited and defined since the first Office Action.

For at least these reasons, Applicants submit that the D'Assignies '913 reference does not teach the claimed combination of elements recited by amended claim 1. As such, the D'Assignies '913 reference cannot be deemed to anticipate claim 1. Along these lines, because independent claim 6 recites similar features to claim 1 that have been proven to be patentable, namely the vacant gap portion, claim 6 is not anticipated by D'Assignies '913 for at least the same reasons presented with respect to claim 1. Accordingly, Applicants request the immediate withdrawal of the §102(b) rejections of independent claims 1 and 6.

In addition, because claims 4-5 and claims 7, and 9-11 depend from independent claims 1 and 6, claims 4-5 and claims 7, and 9-11 cannot be anticipated by

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D'Assignies '913. Accordingly, request the immediate withdrawal of the §102(b) rejections of independent claims 4-5 and claims 7, and 9-11.

Moreover, as best understood, none of the references of record, whether taken alone or in combination, are capable of curing the deficiencies noted above regarding D'Assignies '913. As such, Applicants submit that the references of record cannot be construed as rendering claims 1, 4-7, and 9-11 unpatentable.

## II. Conclusion.

Applicants submit that the entry of this Amendment is proper under 37 C.F.R. §1.116 as the claim changes: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not require any further consideration as the changes incorporate, in one form or another, features already searched; and (c) places the application in better form for an Appeal, should an Appeal be necessary.

Applicants' Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975, Order No. 008378-0303622. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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